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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

MEINECKE DIAZ, SUSANNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3623

DATE MAILED: 11/21/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/659,428

Applicant(s)

VERMA ET AL.

Examiner

Susanna M. Diaz

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 11-27.
- Claim(s) withdrawn from consideration: _____.
8. ☒ The proposed drawing correction filed on 21 October 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Attachment to Advisory Action (Paper No. 12)

1. The Applicant's substitute declaration received on October 21, 2002 overcomes the previously pending objection to the declaration.
2. Figures 1-5 have been received; however, Figure 6 is still missing. Please send in Figure 6.
3. Applicant requests clarification of the location of the embedded hyperlinks in the specification. They are found throughout the first paragraph on page 3 of the specification and include the following: www.compare.net, www.bottomdollar.com, www.top10guide.com, www.shoppingexplorer.com, www.shopfind.com, www.roboshopper.com, www.jango.com. Please remove these hyperlinks from the specification.
4. Upon entry of the after-final amendment, the rejection of claim 19 under 35 U.S.C. 112, 2nd paragraph, would be overcome.
5. Applicant's arguments are deemed to be non-persuasive for the reasons outlined in the previous Office action (paper no. 8).

Furthermore, Applicant argues:

Applicants respectfully submit that ZiffDavis and NetDynamics agree not to provide any price comparison between local stores and they also agree not to direct a buyer to a local store of the choice of the buyer.

Applicants respectfully submit that where two references agree not to do what applicants claim, then any combination of such references will be even less suggestive of the disclosure and claims of the applicants. (Page 6 of Applicant's Response)

Applicant makes an assertion without any support for this assertion. For example, it is not clear where ZiffDavis and NetDynamics allegedly "agree not to provide any price comparison between local stores and they also agree not to direct a buyer to a local store of the choice of the buyer." Applicant's argument is not persuasive.

Applicant argues that "Ziff-Davis does not address sorting of the information. The proposed patent explicitly sorts the information relative to products" (Page 9 of Applicant's Response). In order to present product information retrieved from a database (as taught by Ziff-Davis and discussed in the art rejection), product information must inherently be sorted. This is how database search and retrieval works.

Applicant argues that "Ziff-Davis does not address presenting the information. The proposed claim explicitly presents the information in a plurality of records to the prospective buyer" (Page 10 of Applicant's Response). As stated in the art rejection, Ziff-Davis teaches the provision of "side-by-side product comparisons" (¶ 12). The phrase "side-by-side" implies a visual presentation of these product comparisons.

Applicant argues that "Ziff-Davis does not disclose the type of information being collected [in claim 12]" (Page 11 of Applicant's Response). The Examiner notes that the information collected in claim 12 is listed in the alternative; therefore, only one element of each list needs to be addressed in order to adequately apply art to the claims. This burden has been met by the Examiner, as explained in the art rejection.

As per claim 12, Applicant argues that "Ziff-Davis does not disclose anything about entering attributes into a search key" (Page 11 of Applicant's Response) and "Ziff-Davis does not disclose anything about types of attributes that are entered into a search key" (Page 12 of Applicant's Response). The Examiner respectfully disagrees. Since customers can search Ziff-Davis' database by product category, a search key based at least on product category is inherent to Ziff-Davis. Furthermore, since Ziff-Davis provides "side-by-side product comparisons," this means that Ziff-Davis' database may be sorted at least by product name.

Applicant argues:

...While Ziff Davis provide product and price comparison, they expressly say in paragraph 4 that they guide the shopper through the entire buying process. This clearly expresses that according to Ziff-Davis nothing is to be added to the buying process of Ziff-Davis and it is respectfully urged that the person of ordinary skill in the art better accept the suggestion in Ziff-Davis that Ziff-Davis guides users through the entire buying process and that nothing else and in particular no NetDynamics features are needed. (Page 15 of Applicant's Response)

Applicant's assertion that Ziff-Davis "[guides] the shopper through the **entire** buying process" and therefore it would not have been obvious to modify Ziff-Davis is erroneous. Most inventions arise from improvements over existing, prior art inventions. There is no requirement that the prior art disclosure explicitly state that the described invention **can be** modified in order to use such a disclosure as part of a 103(a) rejection. The Examiner maintains that one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to combine the teachings of Ziff-Davis and NetDynamics to yield the claimed invention for the reasons already outlined in the art rejection.

Applicant argues that "it is not understood where the suggestion comes from to sort according to price and it is believed that it is clear hindsight in view of applicants' invention" (Page 16 of Applicant's Response). The art rejection states:

Ziff-Davis does not expressly disclose the sorting of its product database by price. The Examiner asserts that price is often a factor taken into account when customers shop for products that meet their needs; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to sort Ziff-Davis' product database according to price in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs).

The suggestion to combine teachings (e.g., Official Notice with Ziff-Davis) comes from knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention.

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Applicant argues:

Applicants take exception, the indication of a state abbreviation clearly will in most cases not indicate local availability. Nobody in Buffalo would consider New York City local and nobody in San Francisco would consider San Diego to be local. Apart from that, neither Ziff-Davis nor NetDynamics employ the State abbreviation for directing to local merchants, this is solely the concept of the present Examiner. (Page 17 of Applicant's Response)

First, if Applicant's assertion that "the indication of a state abbreviation clearly will in most cases not indicate local availability" is true, then Applicant implies that the claimed invention is counterproductive since it does not truly provide a customer with an available product located in his/her general vicinity. Second, there are many smaller states in which the indication of a state abbreviation does indeed indicate local availability. Applicant's argument is non-persuasive.

Applicant states, "Applicants urge that both the telephone and the light bulb provide a big convenience to anybody employing them, nevertheless they were eminent invention and clearly not obvious even in view of their extremely high convenience." (Page 18 of Applicant's Response) The Examiner agrees that the telephone and light bulb were "eminent" inventions; however, Applicant is comparing apples and oranges. The overwhelming novelty of the telephone and the light bulb in their time have no bearing on the presently claimed invention.

Applicant argues that "NetDynamics proposes a reservation system for a local chain store, whereas the present invention addresses a product and price competitive system between a plurality of merchants" (Page 19 of Applicant's Response). In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues, "The desirability of the steps of claim 16 are not basis for holding this steps obvious in view of the lack of teaching in both Ziff-Davis and NetDynamics" (Page 21 of Applicant's Response). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, this motivation to combine teachings in the rejection of claim 16 was largely based on "the knowledge generally available to one of ordinary skill in the art."

In conclusion, Applicant's arguments are non-persuasive.